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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,489	07/25/2001	Akira Morikawa	211787US0	4414

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ALEXANDRIA, VA 22314

EXAMINER

WRIGHT, WILLIAM G

ART UNIT	PAPER NUMBER
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1754

DATE MAILED: 05/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/911,489

Applicant(s)

MORIKAWA ET AL.

Examiner

William G. Wright SR.

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 39-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-47 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Applicant's election with traverse of claims 1-38 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that claims 1-38 being made by the sol-gel process are non-supported speculation by the Examiner. This is not found persuasive because the sol-gel process is well known in the art of catalyst preparation and is not speculation. Another method of making catalysts would be solid phase sintering to form the catalyst. Either method, the sol-gel method or solid phase sintering method differs from the instant preparation of forming a solution and calcining the precipitates. Thus the product of Group I, claims 1-38 could be made by either of the cited methods that differ from the instant method of Group II, claims 39-47.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1, 26, 27 and 33 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The use of the clause "wherein the plurality of fine particles comprises oxides of a plurality of metallic elements, and each fine particle independently comprises an oxide

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of one or more of said metallic elements" } does not find support
in either Example 1 or Figure 1.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) The invention was described in (1) an application for patent, published under Section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by EP 794,527.

Note page 3 lines 42 et seq. to page 4 line 14.

Claims 1-38 are rejected under 35 U.S.C. § 102(b) as being anticipated by EP 1,020,216.

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Note the Summary of the Invention and the Detailed Description of the Preferred Embodiments.

Claims 1-38 are rejected under 35 U.S.C. § 102(e) as being anticipated by Suzuki et al. '288 or Suzuki et al. '305. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. § 102(e). This rejection under 35 U.S.C. § 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Note the claims and column 1 lines 65 et seq. in Suzuki et al. '288. The Suzuki et al. '305 reference is pointed to at column 5 line 30 and the claims.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

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skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 1-38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 0,778,071 in view of Berndt et al. '180.

EP '071 teaches the instantly claimed composite oxide at page 2 line 9 et seq. The instantly claimed particle size is not found in EP '071. Berndt teaches the instantly claimed particle size in the claims. It would have been obvious to form the composite oxide of EP '071 in the particle size range of Berndt because each is drawn to the same composite oxide.

Applicants' arguments filed March 17, 2003 have been fully considered but they are not deemed to be persuasive.

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Applicants argue the anticipation rejection made over EP 794,527. The particle size found in the referenced area of the patent is consistent with the claimed particle sizes. The argument about metallic element distribution is not persuasive as the particles of the reference appear to be the same as that of the instant claimed particles. The argument for the reference only using alumina is not persuasive and page 4 lines 8 and 9 are shown to teach alumina and magnesium oxide particles. The product of the applied art still looks the same as the instant claimed product. Applicants must show otherwise. In re Best, 195 USPQ 430 is cited to support the requirement that the applicants must distinguish over applied art that is the same as applicants claim.

Applicants argue the anticipation rejection over EP 1,020,216 as not having a disclosure or suggestion that the reference contains a composite oxide particle with the metallic element distributions of the instant claimed invention. The pointed to areas of the reference teach the use of a composite oxide and the product of the applied art still looks the same as the instant claimed product. Applicants must show otherwise. In re Best, 195 USPQ 430 is cited to support the argument that the applicants must distinguish over applied art that is the same as applicants claim.

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Applicants argue the anticipation rejection over Suzuki et al. '288 or Suzuki et al. '305. The statement that the Suzuki et al. '305 is the U.S. equivalent of, and is thus identical to EP Suzuki et al. '216 is noted. Suzuki '305 teaches the use of solid solutions and composite oxide at the claims. Suzuki et al. '288 teaches the use of solid solutions and composite oxides at the noted areas of the reference. Each reference contains a composite oxide particle with the metallic element distributions of the instant claimed invention. The pointed to areas of the references each teach the use of a composite oxide and the product of the applied art still looks the same as the instant claimed product. Applicants must show otherwise. In re Best, 195 USPQ 430 is cited to support the argument that the applicants must distinguish over applied art that is the same as applicants claim.

The applicants argue EP 0,778,071 in view of Berndt et al. '180 as being not the instant invention due to the lack of the teaching of the structure found in the instant claims. The claims of EP '071 teach the particle diameter of less than 100 nanometers and that the particles agglomerate to a powder. The supporting reference to Berndt et al. teaches submicron size particles for the particles of the composite powder, note claim 10. It would be obvious to form the composite oxide of EP '071 in the particle size of Berndt '180 because each is drawn to the

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same composite oxide. The product of the applied art still looks the same as the instant claimed product. Applicants must show otherwise. In re Best, 195 USPQ 430 is cited to support the requirement that the applicants must distinguish over applied art that is the same as applicants claim. The applied art is argued by the applicants to not show the claimed distribution. The catalysts of the applied art appear to be the same and it will have to be shown by applicants that there is in fact a difference.

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE

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MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William G. Wright, Sr. whose telephone number is (703) 305-7792. The examiner can normally be reached on Monday through Thursday from 6:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on (703) 308-3837. The fax phone number for the organization where this application or proceeding is assigned are (703) 872-9310 for the regular communications and (703) 872-9311 for after final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1495.

WGW SR
W. G. Wright, Sr.:cdc
May 6, 2003

SJB
STEVEN BOS
PRIMARY EXAMINER
GROUP 1100